

REMARKS

Claims 1-17 and 23-34 are pending in this application. In this Response, Applicant has amended certain claims. In light of the Office Action, Applicant believes these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicant respectfully submits that the claim amendments do not limit the range of any permissible equivalents.

In particular, independent claims 1, 23, and 30 have been rewritten to further describe the staged resin film of the invention. For example, claim 1 has been rewritten to further clarify the placement and thickness of the staged resin film (Specification at page 8, lines 27-30). In addition, independent claim 23 has been amended to clarify that the thermosetting staged film is part of a golf ball component in a partially cured state, *i.e.*, an unfinished manufactured state, with a hardness less than a completely cured staged resin film (Specification at page 5, lines 2-4 and page 6, lines 11-13). Claim 30 has been similarly rewritten with additional elements, such as thickness, hardness, tensile strength, and construction (Specification at page 5, lines 2-4, page 6, lines 11-16, and page 8, lines 22-23). Dependent claims 16-17, 25, and 34 have been amended to recite additional embodiments fully supported by the Specification. Finally, various dependent claims have been amended to satisfy § 112 requirements in light of the changes to the independent claims.

As no new matter has been added by the amendments herein, Applicant respectfully requests entry of these amendments at this time.

THE REJECTION UNDER 35 U.S.C. § 103

Claims 1-14 and 23-34 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,730,665 to Shimosaka *et al.* in view of U.S. Patent No. 4,847,319 to Bandlish. In addition, claim 15 was rejected as obvious over Shimosaka '665 in view of Bandlish and further in view of U.S. Patent No. 5,749,796 to Shimosaka *et al.* Finally, claims 16 and 17 were rejected as obvious over the combination of Shimosaka '665, Bandlish, and Shimosaka '796 further in view of U.S. Patent No. 6,068,561 to Renard. Applicant respectfully disagrees with these rejections for the same reasons outlined in the previous Office Action filed on January 2, 2003, which are incorporated by reference herein in their entirety. In an effort to expedite allowance of the pending claims, however, Applicant has rewritten the claims to further distinguish the invention from the cited references.

As detailed below, there is no suggestion or motivation to make the proposed modifications to Shimosaka '665 to arrive at the present invention because to do so would

render Shimosaka '665 unsatisfactory for its intended purpose. The remaining cited references do not cure the deficiencies of Shimosaka '665 for the reasons that follow.

With regard to amended claim 1, Shimosaka '665 generally discloses a golf ball having multiple layers wherein the innermost layer 3 (closest to the core) has a thickness of about 1 to 2 mm. *See, e.g.*, Col. 3, lines 39-41. In fact, Shimosaka teaches:

[a]n innermost layer of less than 1 mm thick would fail to provide a cover with acceptable performance.

Col. 3, lines 41-43. In contrast, claim 1 now recites a thickness of an intermediate layer disposed about the core of less than 0.13 mm thick (claim 1). Given that Shimosaka '665 expressly *teaches away* from the present invention, a skilled artisan would not be motivated to modify Shimosaka '665 by using an innermost layer with a thickness of less than 1 mm. To do so would render the Shimosaka '665 golf ball unsatisfactory for its intended purpose. Thus, Shimosaka '665 does not render the present invention obvious.

Claims 23 and 30 have both been rewritten to clarify that the golf ball component formed from a thermosetting staged resin film is in a partially cured state, *i.e.*, the claims are no longer directed to a "finished" golf ball. Because the staged resin film is only partially cured, the golf ball component thus remains tacky or sticky to the touch. In contrast, however, the main objective of Shimosaka '665 is a "smooth mold release" (as discussed in detail in the last Response to Office Action filed on January 2, 2003). As such a skilled artisan would not have been motivated to modify Shimosaka '665 to use a tacky or sticky material as a mold release. *See* MPEP § 2143.01 at 2100-124-125 ("If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."). For these reasons, Applicant respectfully submits that Shimosaka '665 does not disclose or even suggest the present invention, as presently recited in independent claims 23 and 30.

The Examiner relied on Bandlish for its disclosure of a polyurethane composition comprising a blocked isocyanate, a ketone or aldehyde. *See, e.g.*, Office Action at page 3. Bandlish does not, however, remedy the many deficiencies of Shimosaka '665. In fact, Bandlish is completely silent as to the use of his invention in any manner related to the golf industry. In addition, the combination of Bandlish and Shimosaka '665 would render Shimosaka '665 useless for its stated objective because Bandlish teaches to use a highly adhesive material not suitable as a mold release. Thus, a skilled artisan would have had no motivation to combine Bandlish with Shimosaka '665, nor have any expectation that such a combination would be

successful. And, even if such a combination were made, the combination would not result in the invention as presently claimed.

Moreover, neither Shimosaka '796 nor Renard cure the deficiencies of Shimosaka '665 and Bandlish. In particular, Shimosaka '796 is relied on by the Examiner for the wound ball disclosure, however, Shimosaka '796 does not provide any teaching for a staged resin film intermediate layer disposed about the core as presently recited in independent claim 1. In fact, Shimosaka '796 teaches a relatively thick wound layer closest to the core with a dual cover disposed thereon. *See, e.g.*, Col. 2, line 55 to Col. 3, line 22. In contrast, claim 1 of the present invention recites a thin staged resin film layer disposed about the core. In addition, Shimosaka '796 does not provide any motivation to one of ordinary skill in the art to ignore the primary purpose of Shimosaka '665 to provide "smooth mold release" to arrive at the invention now recited in independent claims 23 and 30.

Renard generally describes thin core layers, but also does not provide the requisite motivation to completely disregard the teachings of Shimosaka '665 to arrive at the present invention. For example, both Renard and Shimosaka '665 teach thermoplastic compositions, whereas the staged resin film of the present invention is thermoset.

In view of the foregoing, Applicant respectfully submits that no combination of Shimosaka '665, Bandlish, Shimosaka '796, or Renard renders the present invention. Thus, Applicant respectfully requests reconsideration and withdrawal of the § 103 rejections based thereon.

CONCLUSION

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicant invites the Examiner to contact the undersigned attorneys to discuss any remaining issues.

No fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Swidler Berlin Shereff Friedman, LLP Deposit Account No. 195127, Order No. 20002.0096.

Respectfully submitted,
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